Remarks

Claims 1-19 remain pending.

Claims 1-19 are rejected under 35 USC 103(a) over Clark et al., U.S. Patent 5,710,889 ("Clark") in view of Jai et al., U.S. Patent 5,991,402 ("Jai"). Applicant respectfully traverses this rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In the present case, the cited combination of references fails to meet each of the three basic criteria required to establish a *prima facie* case of obviousness. As such, the rejection under 35 USC 103(a) is defective.

In the Final Office Action, the Examiner alleges that Clark's system includes an institutional server for delivering institutional data to a customer, "wherein the institutional server includes a system for separately serving a first database containing private and a second database (see., fig 1, abstract, col 3, lines 18-35, repository and archive facility)." Independent claim 1 (and similarly independent claims 10, 14, and 18), however, includes an institutional server, wherein the institutional server includes a "system for separately serving **a first database containing private data** and **a second database containing public data.**" Clark fails to teach or suggest separate first and second databases containing private and public data, respectively. On the contrary, the repository and archive facilities of Clark, which the Examiner equates with the claimed first database containing public data and second database containing public data,

respectively, are used to store the same type of data. Specifically, as disclosed in col. 6, lines 30-35, the repository 11 maintains a record of all messages sent through the global interface device (GID) 10. After a predetermined period of time has elapsed (e.g., 45 days), the messages are moved from the repository 11 to a secondary archive facility 18. Clearly, the same type of data (i.e., messages) is stored in both the repository 11 and the archive facility 18; Clark provides no disclosure regarding the separate storage of private and public data in different databases as claimed.

It should be noted that the Examiner's statement that Clark discloses an institutional server including a "system for separately serving a first database containing **private** and a second database" is confusing and incomplete. What is a "private"? Is the Examiner alleging that the second database contains a certain type of data? Clarification of this statement is once again requested by Applicant.

Claim 1 also includes a "service provider, wherein the service provider includes a system for **receiving an encrypted version of the private data and an unencrypted version of the public data from the institutional server.**" Clark's system clearly fails to teach or suggest such a service provider. Similarly, Clark's system clearly fails to teach or suggest the claimed step of "storing an encrypted copy of the private data and an unencrypted copy of the public data with an intermediary service provider," (claim 10), the claimed step of "loading to a client the encrypted private data from the institution and the unencrypted copy of the public data from the service provider," (claim 14), and the claimed "system for providing a copy of the second database of unencrypted data to an intermediary service provider" (claim 18).

In the Final Office Action, the Examiner equates Clark's on-line transaction processors (OLTPs) 12(1,2, ... n) with the claimed "service provider." In particular, the Examiner states

that the "customer connects to the system whenever desired to access each of the services, and the interface device stores and routes messages between the customers and each of the **service providers** at the respective times when the customers' facilities and the **service providers'** facilities are operative." Contrary to the claimed invention, however, Clark's OLTPs do not receive private and public data that is separately served from a first database containing private data and a second database containing public data.

The Examiner alleges that Clark fails to disclose an "encrypted version of the private data and an unencrypted version of the public data." The Examiner attempts to remedy this glaring deficiency of Clark by relying on Jai. In particular, the Examiner states that Jai "discloses a method/system that enables software-on-demand and software subscription services based on a dynamic transformation filter." The Examiner also states that an "encrypted material installed on the computer is encrypted by decrypting a first version of the material to produce an unencrypted version." This statement makes no sense whatsoever. It is not clear how **encrypted** material can be **encrypted** by "**decrypting** a first version of the material to produce an **unencrypted** version." Clarification of this confusing statement is requested.

Applicant submits that Clark and Jai fail to teach these, as well as other numerous claim features of the present invention. For instance, with regard to claim 1, the Examiner appears to allege (see above) that Clark teaches an institutional server for separately serving a first database of private data and a second database of public data. However, no such distinction is made between private and public data in Clark. On the contrary, Clark only discloses the serving of "private" messages to customer facilities 12, wherein the messages are communicated from repository 11 to a customer facility(ies) 12 only in response to an approval by entitlement system 16. Claim 1 further recites "a service provider, wherein the service provider includes a system

for receiving an encrypted version of the private data and an unencrypted version of the public data from the institutional server." As stated above, Clark fails to disclose a service provider that receives encrypted private data and unencrypted public data from an institutional server. Further, since Clark fails to disclose an institutional server for separately serving a first database of private data and a second database of public data, Clark cannot possibly disclose the display of a merged version of the private and public data. In the Office Action, the Examiner alleges that this feature is disclosed in FIGS. 15, 17, 20, 23, 24, 28, and in col. 6, lines 37-47, col. 14, lines 10-22, and col. 21, lines 16-25. However, the Examiner has made no attempt to distinguish between private and public data in any of these FIGS./sections of Clark. Clarification is again requested.

Attempting to modify Clark using Jai fails to remedy these numerous deficiencies. Jai teaches a system that resides on a computer operating system and essentially allows encrypted material to remain encrypted if it is to be delivered over a network, or be decrypted if it is required by an operating system component. Jai's system resides at a single critical data path in a computer operating system. Jai does not teach or suggest a system for processing **separate** databases of encrypted material and unencrypted material. Accordingly, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, nor is there a reasonable expectation of success.

Moreover, Jai specifically teaches away from the concept of an intermediate service provider that receives "an encrypted version of the private data and an unencrypted version of the public data." Jai explicitly states that the "apparatus utilized in this invention **does not create any intermediate storage** of decrypted material that is under the protection of this

technology." (See column 3, lines 24-27.) Accordingly, a person skilled in the art would clearly not be motivated to combine the two references.

Furthermore, there is clearly no teaching in either reference that allows a customer to "remain anonymous to the intermediary service provider," as recited in claims 3, 10, 14, and 18. The Examiner's position that Jai discloses this in the abstract, Figure 1 and item 108 is clearly without merit, as Jai teaches away from an intermediary service provider; the abstract makes no mention of anonymity; and Figure 1 and item 108 do not show any mechanism for allowing a customer to remain anonymous.

Applicant appreciates the Examiner's voluminous recitation of case law regarding obviousness. However, the Examiner has not directly addressed any of the arguments presented by Applicant to date, and repeated above, regarding the lack of establishment of a *prima facie* case of obviousness.

Accordingly, Applicant respectively submits that all claims are in condition for allowance. If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

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